

REMARKS

Claims 1-10 are all the claims pending in the application. This Amendment amends claims 5 and 7, and addresses each point of rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

Applicants thank the Examiner for initialing the Information Disclosure Statement filed October 10, 2001.

Applicants also thank the Examiner for clarifying by telephone on June 19, 2003, that claim 3 is rejected based on Baird *et al.* and U.S. Patent 5,028,109 to Lawandy, rather than Baird and Raymond *et al.* as stated in the Office Action at the beginning of the rejection.

Applicants respectfully request that, in the next Action, the Examiner acknowledge the claim for foreign priority under 35 U.S.C. § 119 and receipt of the priority documents. Priority is claimed from Japanese Patent Application No. 2000-309846 filed October 10, 2000. A copy of the priority application was submitted with the present application on October 10, 2001.

Claim Rejections - 35 U.S.C. § 112

Claims 5 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Regarding claim 5, the Examiner asserts that it “is not clear what axis the wavelength plate is orthogonal to because there could be a lot of optical axes.” Applicants amend claim 5 to identify the optical axis as “an optical axis of light incident on the wavelength plate.”

Regarding claim 7, the Examiner asserts that it is not clear how the photodiode and beam splitter are shielded from light and still perform their functions. Applicants amend claim 7 to recite: “the beam splitter and the photodiode are shielded from scattered light.”

No new matter is added. In view of these amendments, reconsideration and withdrawal of the § 112 rejections are respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Claims 1-2 and 4-10 are rejected under 35 U.S.C. § 102(a) as anticipated by U.S. Publication 2002/0005396A1 to Baird *et al.* (“Baird”).

Since the October 10, 2000 priority date of the present application is earlier than the July 11, 2001 U.S. filing date of Baird, Applicants submit herewith a verified translation of the priority document (Japanese Application No. 2000-309846) to perfect the claim for priority.

Accordingly, Baird is prior art only to the extent that Baird’s provisional application (60/217,746 filed July 12, 2000) supports the subject matter relied upon in Baird as basis for the rejection. *See* MPEP § 2136.03(III and IV); *see also* MPEP § 706.02; and *Tronzo v. Biomet Inc.*, 47 USPQ 2d 1829, 1832 (Fed. Cir. 1998). Where subject matter is newly added, that newly added subject matter does not constitute prior art. A copy of U.S. Provisional Application No. 60/217,746 is submitted herewith for the Examiner’s convenience.

As explained below, Applicants respectfully submits that those portions of Baird that constitute prior art do not disclose, teach, or suggest each feature of the claimed invention.

The Examiner cites the substitution of the half-wave plate in Baird as anticipating the claimed wavelength plate. However, Provisional Application 60/217,746 does not discuss using a half-wave plate as a substitute for the AOM in series with the UV beam (*i.e.*, AOM 80a in Baird Fig. 3). *See* 60/217,746, page 4, lines 5-12. The provisional application does suggest using a half wave plate for the AOM in series with the green light path (*i.e.*, AOM 80b in Baird

Fig. 3; *see* 60/217,746, page 5, lines 14-15). However, this teaching still does not afford the earlier priority date to Baird for the use of a half wave filter in series with the UV beam.

Accordingly, Baird's provisional application disclosure using a half wave plate as a substitute for the green-light path AOM does not support anticipation of the claimed wavelength plate by Baird, since there is no support for such a substitution in the UV path.

Similarly, the claimed removing portion is not anticipated. Specifically, the provisional application of Baird only discloses the blocking of green light in the UV path, which is the second harmonic produced by the laser--not the fundamental as required in claim 1. *See* 60/217,746 page 4, lines 3-5.

Moreover, if the "nonlinear optical process" utilized by laser 54 of Baird to generate the second harmonic green light were construed as the claimed light wavelength converting element, and the second optical path 68 (*i.e.*, green) of Baird was considered instead of the first optical path 62 (*i.e.*, UV), each limitation of claim 1 still is not met. Specifically, there is no teaching in 60/217,746 to support there being a removing portion in Baird's second optical path 68.

For at least these reasons, Applicants submit that claim 1 is not anticipated. Further, Applicants submit that dependent claims 2 and 4-10 are also not anticipated, at least by virtue of being further limitations on claim 1.

Moreover, claim 2 is not anticipated, as the filter disclosed in 60/217,746 as receiving the light from the nonlinear crystal is a green filter, not an IR filter as required in the claim.

Moreover, claim 4 is not anticipated, as there is no support in 60/217,746 for a half-wave or quarter-wave plate at the light exiting side of the non-linear crystal 72.

Further, with regard to claim 5, Applicants respectfully submit that there is no support for the Examiner's anticipation rejection. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. Baird does not explicitly disclose that the half-wave plate is disposed substantially orthogonal to the optical axis. On page 3 of the Office Action, the Examiner states "since Baird discloses the rotation half-plate, it could be orthogonal to an optical axis" (emphasis added). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112. That the rotation half-plate "could" be orthogonal, but is not necessarily orthogonal, does not support that the feature is inherent. Accordingly, claim 5 is not anticipated.

Further, claims 9 and 10 require that the light attenuating portion is provided at a light exiting side of the wavelength converting element *and* at a light entering side of the beam splitter. The Examiner's rejection does not address that the light attenuating portion must be at a light entering side of the beam splitter. Attenuator 106 in Fig. 6 of Baird is not at a light entering side of the beam splitter. Moreover, there is no support for the light attenuating portion being at a light entering side of the beam splitter in provisional application 60/217,746. Accordingly, claims 9 and 10 are not anticipated.

Claim Rejections - 35 U.S.C. § 103

Claim 3 is rejected as obvious based on Baird combined with U.S. Patent 5,028,109 to Lawandy ("Lawandy"). Applicants respectfully submit that the combination of Lawandy and Baird does not render obvious each deficiency of Baird discussed above with regard to claim 1,

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 09/972,960

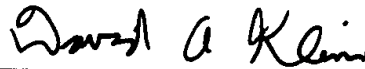
from which claim 3 depends. It is improper to infer any suggestion of desirability or motivation from passages in Baird that do not constitute prior art. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



David A. Klein
Registration No. 46,835

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: October 10, 2003